## REMARKS

Claims 91-99 are added, hence, claims 1-99 are all the claims pending in this application.

The Examiner rejects each of the independent claims, namely, claims 1, 30, 31, 60, 61 and 90, and many of the dependent claims, under 35 U.S.C. §103(a) as being unpatentable over Pajak. Applicant respectfully traverses the rejection at least because there is no teaching or suggestion in the prior art to modify Pajak as asserted in the Office Action, and even if modified as asserted the reference would not satisfy all the limitations of the claims.

Claim 1, for example, is directed to a method for creating a compilation from a collection of content stored in a database. The method includes presenting a plurality of selectable objects to a user, in which each object is associated with a subset of the collection of content. The method creates a compilation of the content associated with each selected object, in response to a user selecting one or more of the objects. It is respectfully submitted that the prior art neither teaches nor suggests creating a compilation of content associated with objects that have been presented to a user and selected.

Pajak relates to a system for presenting to users a container-type data objects that is shared between the users. Pajak, in Fig. 1, shows such a shared object, namely a shared book 40, that is shared between workstations 14a and 14b. The shared book 40 appears as an iconic representation on the screens of both workstations. The shared book 40 is a container that can contain a plurality of related structured data objects such as a folder (i.e., Folder A), as shown in Fig. 3. Pajak, at col. 10, beginning at line 48, identifies various commands that a user can enter via a keyboard to operate on an object, such as commands for deleting, copying, moving, and opening an object.

In order to render the claims unpatentable there must be a teaching or suggestion in the prior art to modify Pajak as asserted in the Office Action. "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure." MPEP § 2143. The only support identified in the Office Action for the position that it would have been obvious to modify Pajak to meet the claim limitation of creating a compilation of content, is speculation that the prior art system could be used to meet all the claim limitations. For example, it is asserted that "[a] user could edit a document ...," and "a user could compile the content associated with a selected object ..."

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(Emphasis added) However, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01.

It is respectfully submitted that the prior art does not suggest modifying Pajak as asserted. The Office Action states that it would have been obvious to modify Pajak "in order to collect and edit the content associated with a selected object." The prior art, however, neither teaches nor suggests collecting selectable objects in order to edit them. Pajak, at col. 10, lines 48-60, discusses the <OPEN>, <COPY>, <MOVE>, and <DELETE> commands and discloses that a user can enter them from a keyboard to operate on an object. But Pajak neither teaches nor suggests using those functions to collect or compile selected objects, whether to edit them or for any other reason. Accordingly, it is respectfully submitted that there is no teaching or suggestion to modify Pajak as asserted in the Office Action, and hence, Pajak does not render claim 1 unpatentable.

Even if the teachings of Pajak were modified as asserted in the Examiner, all the limitations of the claims would not be satisfied. Claim 1 requires creating a compilation of content "in response to a selection by a user of one or more of said objects." The Office Action refers to Folder A shown in Figs. 3 and 4 as being selected and asserts that a user could use the <OPEN>, <MOVE>, <COPY> and <DELETE> commands to create a compilation of documents. However, using the system of Pajak in such a speculative manner would not create a compilation in response to a user selecting each such document as required by claim 1. Rather, any documents that might be collected together by using those commands would be collected in response to the user entering those commands and not in response to selecting the objects. Accordingly, even if Pajak were modified as asserted, it would not satisfy all the limitations of claim 1.

The remaining independent claims contain similar limitations to those discussed above in claim 1, and accordingly, it is respectfully submitted that they are patentable over the prior art for at least the same reasons. The remaining dependent claims, rejected under §103 in view of Pajak, also are patentable for the reasons discussed above.

Claims 2 – 3, 29, 32 – 33, 59, 62 – 63 and 89 are rejected under 35 U.S.C. §103(a) as being unpatentable over Pajak in view of ksinclair.com and a New York Times article "The New

York Times on the Web." Applicant respectfully submits that these claims are not rendered unpatentable by the asserted prior art for the reasons discussed above and because the secondary references do not satisfy the deficiencies of Pajak.

Claims 4 – 5, 7, 28, 34 – 35, 37, 59, 64 – 65, 67 and 88 are rejected under 35 U.S.C. §103(a) as being unpatentable over Pajak in view of ksinclair.com. Applicant respectfully traverses the rejection at least for the reasons discussed above with respect to claim 1 since ksinclair.com does not satisfy the deficiencies of Pajak.
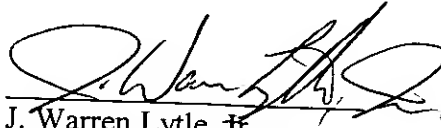
Claims 22, 52 and 82 are rejected under 35 U.S.C. §103(a) as being unpatentable over Pajak in view of a Barnes and Noble reference entitled "Entertainment We Recommend." The Barnes and Noble reference merely describes books that are recommended based on various categories such as E-books, music, magazines, etc. The Barnes and Noble reference does not cure the deficiencies of Pajak discussed above, and accordingly it is respectfully submitted prior art does not render these claims unpatentable for the reasons discussed above.

New claims 91-99 contain by reference all the limitations of one of the independent claims, and hence, are patentable for at least the same reasons.

In view of the foregoing, Applicant respectfully requests the Examiner to find the application in condition for allowance. However, if for any reason the Examiner believes that the application is not now in condition for allowance, the Examiner is respectfully requested to call the undersigned to resolve any issues and to expedite the disposition of the application.

Applicant hereby petitions for any extension of time that may be required to maintain the pendency of this case, and any required fee for such extension is to be charged to Deposit Account No. 05-0460.

Respectfully submitted,

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